



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Yanagimachi et al.
Serial No. : 09/371,648
Title : Mammalian Transgenesis by
Intracytoplasmic Sperm Injection

Art Unit :

Examiner :

The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

I hereby certify that this correspondence
is being deposited today with the United
States Postal Service as first class mail in
an envelope addressed to: Assistant
Commissioner for Patents Washington,
D.C. 20231

on January 28, 2000
By: Suzanne O'Brien

DECLARATION OF CALVIN P. GRIFFITH

Sir:

I hereby declare and state as follows:

1. I represent ProBio, Inc. ("ProBio") in connection with the above-referenced patent application. ProBio is the licensee of that application from the University of Hawaii (the "University").

2. One of the inventors on the above-referenced application, Dr. Yanagimachi, has executed an assignment in which he has assigned his rights in the application to the University. The other inventor, Dr. Anthony Perry, disputes that he is obligated to assign his rights to the University. Dr. Perry has filed a lawsuit against the University that relates to this issue.

3. In early August 1999, when the above-referenced application was being prepared for filing, I spoke with Jeff Harris and Terry Rifkin (both of whom are attorneys) with

#3

regard to Dr. Perry executing an inventor's oath or declaration. Mr. Harris was (and, as I understand it, remains) Dr. Perry's attorney; he was and is representing Dr. Perry in the above-referenced lawsuit. Mr. Rifkin was also Dr. Perry's attorney.

4. I told each of Mr. Harris and Mr. Rifkin that we had prepared a regular utility patent application based on U.S. Provisional Application No. 60/096,078. That regular utility application, when filed (see paragraph 7 below), was assigned serial no. 09/371,648. I offered to have Dr. Perry inspect the application and sign an inventor's oath or declaration therefor. Mr. Harris and Mr. Rifkin told me that Dr. Perry would not sign an inventor's oath or declaration at that time.

5. The patent application was sent to the offices of Cades, Schutte, Fleming & Wright, in Honolulu, Hawaii, to be available for Dr. Perry to review there.

6. I understand from Martin Hsia of Cades, Schutte that Dr. Perry inspected the application on August 10, 1999. Mr. Harris and Mr. Rifkin told me in advance of that review that Dr. Perry would not sign an inventor's oath or declaration. I did not speak to Dr. Perry personally because he was represented by counsel.

7. Dr. Barbara Arndt and I filed the above-referenced application on August 10, 1999, in the name of Dr. Yanagimachi. We did not name Dr. Perry as a co-inventor because we had not been able to confirm with Dr. Yanagimachi that Dr. Perry was a co-inventor on the application as filed. Dr. Yanagimachi has since confirmed that Dr. Perry is a co-inventor on the application as filed.

8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the

#3
United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.


Calvin P. Griffith